

Hon. Charles A. Legge (Ret.)
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Special Master

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
OAKLAND DIVISION

TESSERA, INC., et al.,

Plaintiff,

vs.

ADVANCED MICRO DEVICES, INC., et al.,

Defendants.

CASE NO. C 05-4063 CW (EDL)
JAMS Reference No. 1100049599

**ORDER REGARDING MOTION
FOR LEAVE TO SERVE
SUBPOENA *DUCES TECUM* ON
CAE ASSOCIATES, INC.**

AND RELATED COUNTERCLAIMS

Siliconware Precision Industries Co., Ltd. and Siliconware U.S.A., Inc. ("SPIL") have made a motion for leave to serve a subpoena *duces tecum* on Computer Aided Engineering Associates, Inc. ("CAE"). The motion has been referred to the undersigned Special Master by United States District Judge Claudia Wilken. Under the December 15, 2006 order of the Court appointing the undersigned as Special Master for Discovery, the Special Master is empowered to

ORDER REGARDING MOTION FOR LEAVE TO SERVE SUBPOENA *DUCES TECUM* ON CAE ASSOCIATES, INC.

1 adjudicate and resolve disputes, and not simply make recommendations to Court; paragraphs 1
2 and 2.

3 The subpoena which SPIL seeks to serve is dated April 30, 2009, under the title of court
4 and cause of the United States District Court for the District of Connecticut.

5 CAE objects to the service of the subpoena and has made its own motion to quash the
6 subpoena in Connecticut federal court. The only objection raised by CAE at the present time is
7 that the service of the subpoena would be a violation of the stays in the above-entitled action,
8 which were entered by the Court on May 24, 2007 and August 5, 2008. Those stays were issued
9 in deference to proceedings before the International Trade Commission, which have not as yet
10 been concluded. CAE has reserved the right to raise other objections to the subpoena, which
11 would apparently be made after the subpoena has been served. But as stated, the sole ground for
12 attempting to quash the subpoena in the Connecticut court is the stays pending in this action. The
13 Connecticut court has been advised of SPIL's motion before this Court, and it has taken no
14 action on CAE's motion to quash.

15 A telephone hearing was held on October 13, 2009 on SPIL's motion. Counsel for SPIL
16 appeared by telephone, as did counsel for Tessera speaking on its own behalf and on behalf of
17 CAE. Certain other interested defendants also appeared. At the conclusion of the hearing the
18 Special Master gave an oral ruling granting SPIL's motion, which is hereby confirmed by this
19 written order.

20 The documents sought by the subpoena appear to be relevant to the issues in the ITC
21 proceeding and in this action. Though the Special Master cannot identify some of the documents
22 listed in the subpoena because they are stated in electronic format, it appears that the documents
23 sought by the subpoena pertain to work done by CAE for Tessera in this and other litigation
24 involving Tessera's patents. Relevance is also apparent from the fact that CAE's work would
25 necessarily involve the scope and claims of Tessera's patents.

26 The purpose of the subpoena is not for the immediate production of the documents, but
27 for their preservation by CAE. Some special circumstances must therefore be shown. SPIL has
28 done so by reference to CAE's motion in the Connecticut court. Page three of CAE's
memorandum of law indicates that the documents presently under CAE's control could be

1 destroyed at any time because of the expiration of protective orders in other cases. SPIL would
2 be prejudiced by the loss of such material relevant to the scope of Tessera's patents.

3 It is therefore ordered as follows:

- 4 1. SPIL's motion is granted.
- 5 2. The stays heretofor entered in this case are lifted for the sole purpose of permitting
6 SPIL to serve the subpoena *duces tecum*.
- 7 3. SPIL hereby is granted leave to serve the subpoena *duces tecum* on CAE.
- 8 4. The subpoena *duces tecum* is for the purpose of compelling CAE to preserve the
9 records, and CAE is not required to produce any documents pursuant to the subpoena
10 until further order of this Court.
- 11 5. The parties are to advise the United States District Court in the District of
12 Connecticut of the issuance of this order.

13 IT IS SO ORDERED.

14 Dated: October 20, 2009

15 Charles A. Legge
16 Hon. Charles A. Legge (Ret.)
17 Special Master
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